

## R E M A R K S

Claims 1-67 are pending in the application. All pending claims stand rejected under 35 U.S.C. §103(a) as unpatentable over Yamamoto (U.S. Patent No. 6,078,663) in view of Kunigami (U.S. Patent No. 5,508,817). The Yamamoto reference has been relied upon by the Examiner as a reference in each of the Office Actions in this case. Applicants have traversed the Examiner's rejection in two prior responses, and the Examiner has not responded to Applicant's arguments. Applicants respectfully request that the Examiner "take note of the applicant's argument[s] and answer the substance of [them]" as required by MPEP §707.07(f). Applicants respectfully request reconsideration and further examination of the pending claims in view of the arguments presented herein and in accordance with 37 CFR §1.112.

### 35 U.S.C. §103(a) Rejections

Claims 1-67 stand rejected under 35 U.S.C. §103(a) as unpatentable over Yamamoto (U.S. Patent No. 6,078,663) in view of Kunigami (U.S. Patent No. 5,508,817). Applicants respectfully traverse this ground of rejection. The Examiner is respectfully directed to the distinctions set forth by the Applicants in their Amendments and Responses to the first two Office Actions. In particular, the Yamamoto reference (and the newly-cited Kunigami reference) fails to teach or suggest a system which has a (1) "means for forwarding the information received at [a] public fee address to a private address associated with the mail recipient", or (2) "means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient". Prior to reciting distinctions over the Yamamoto reference, Applicants will first discuss the newly cited Kunigami reference.

The Kunigami reference describes an electronic mail accounting system. The Kunigami reference system includes the ability for a sender to designate who pays (the sender or the recipient) for various transmission costs associated with an e-mail (see Col.2, lines 10-15). In particular, the sender must pay the transmission cost associated with sending the message from the sender to an electronic mail center, but the sender may designate whether the sender or the recipient is to pay the transmission cost associated with sending the message from the electronic mail center to the recipient (see Col.1, lines 28-39). The accounting system of the Kunigami reference is described with respect to a typical e-mail system configuration having a sender, a

recipient having an e-mail address, and a central server that routes e-mail messages from senders to recipients (see Figure 2).

The Examiner has asserted that the Kunigami reference teaches "forwarding the information to a private address." Applicants respectfully disagree with the Examiner's statement. The Kunigami reference only contemplates a single, standard e-mail address and system (albeit with a special accounting system component). No private addresses are described, taught, or suggested in the Kunigami reference. In contrast, presently claimed embodiments provide "means for forwarding the information received at [a] public fee address to a private address associated with the mail recipient" (see, claim 1). Nor does the Kunigami reference teach or suggest "means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient." The Kunigami reference describes allowing a sender to designate who pays certain transmission costs associated with an e-mail, but nowhere in the Kunigami reference is a recipient allowed to designate a fee for sending the e-mail. To assist the Examiner in visualizing advantages of the presently claimed embodiments (and distinctions between the Kunigami reference and presently claimed embodiments), an example is presented below.

For instance, assume the sender is a direct marketer wishing to send millions of unsolicited e-mails (spam) to millions of e-mail recipients (see Pg.2 and the remainder of the specification generally). Some of the recipients are identified to the public (e.g., the direct marketer/sender) by a public e-mail address. The public e-mail address is an e-mail address maintained, for example, by a central electronic mail server. Some of the recipients may also have a private e-mail address generally known only by the electronic mail server. Thus, the direct marketer may send e-mail to the public address, where certain rules (e.g., payment rules) may be applied to the e-mail prior to allowing the e-mail to proceed to the recipient's private e-mail address. The direct marketer is never privy to the recipient's private e-mail address, and thus may not send unsolicited messages directly to the recipient. Instead, such unsolicited messages must pass through the central server via the public e-mail address, where they may be filtered, charged a fee, etc.

Further, allowing the recipient to charge fees to an e-mail sender provides a mechanism for allowing certain unsolicited e-mails to be directed to the recipient's private address in exchange for some amount of compensation or consideration. In the example above, an e-mail

recipient may set a fee of five dollars to be charged to any, all, or a certain selection of e-mail senders and/or e-mail sender types. The direct marketer may then send an unsolicited e-mail to the recipient, and the e-mail will be allowed to be directed to the recipient's private e-mail address only upon the direct marketer paying the five dollar fee to the recipient or another designated entity (such as the recipient's internet service provider or a charity).

The Kunigami reference does not contemplate such features, and thus fails to teach or suggest elements of the claimed embodiments, either alone or in combination with other references cited by the Examiner. To the contrary, the Kunigami reference, under the same direct marketing facts, would actually allow a direct marketer/sender not only to send messages directly to a recipient, but would also allow the direct marketer to charge a portion of the transmission fee to the unsuspecting recipient. The Kunigami reference does not block, filter, or compensate the recipient for receiving unsolicited e-mails. In contrast, the Kunigami reference would allow the direct marketer to charge the recipient for costs associated with the sending of the direct marketer's unsolicited e-mail(s).

Further, and as described in the previous responses to both previous Office Actions, the Yamamoto reference fails to teach or suggest elements of the claimed embodiments. As described in Applicants' previous responses, the Yamamoto patent describes a system related to the enciphering and deciphering of transmitted data. As described in the Abstract, the Yamamoto reference relates to a communication device that includes an accounting circuit for calculating an amount to charge a user for data. The Examiner points out that the Yamamoto patent describes an information providing center for providing information to a user, at the request of the user. The user is charged for information provided to him (e.g., based on the amount of information which he requested).

The Examiner has asserted that the Yamamoto reference teaches a means for determining a fee "wherein the fee is based upon a preferences record defined by a mail recipient." Applicants respectfully disagree with the Examiner's statement. The Yamamoto reference only contemplates allowing a fee to be determined by the distributor/sender of the information. Having a fee determined by or based on preferences of a recipient is not described, taught, or suggested in the Yamamoto reference. In contrast, presently claimed embodiments provide "means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient" (see, claim 1). The Examiner has also stated that "Yamamoto fails to teach

and [sic] inventive concept of a...means for forwarding the information to a private address." Applicants agree with the Examiner that the Yamamoto reference fails to teach or suggest such a "means for forwarding the information received at [a] public fee address to a private address associated with the mail recipient." To assist the Examiner in visualizing one advantage of the presently claimed embodiments (and a distinction between the Yamamoto reference and presently claimed embodiments), an example is presented below.

For instance, continuing the direct marketing example described in conjunction with the Kunigami reference, assume a direct marketer wishes to send unsolicited e-mails to various recipients. In some embodiments, although the direct marketer may send an e-mail to a recipient (generally through a public fee address), the recipient may choose if and how the sender (direct marketer) is charged for sending such e-mails. In such a manner, unwanted e-mails may be received (generally at a private address) only after the direct marketer has paid the required, recipient-defined fee. Under the Yamamoto reference, if a recipient (information requestor) were permitted to charge the sender (publisher) for sending the information, the purpose of the Yamamoto reference would be severely frustrated. In fact, because the Yamamoto reference describes an information providing system (like a newspaper website where users pay to download or view news articles) where information is provided for a fee, allowing users to define the fee would result in no fee ever being collected (excepting the rare individual that may feel guilty or charitable and thus effectively charge themselves a fee on behalf of the information provider).

Applicants respectfully assert that the Yamamoto and Kunigami references fail to teach, suggest, or render obvious, either alone or in combination, embodiments of the present invention as recited in amended claim 1, and as described above. In particular, the Yamamoto and Kunigami references fail to disclose, teach, or suggest a method that includes: (1) "means for forwarding the information received at [a] public fee address to a private address associated with the mail recipient", or (2) "means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the mail recipient". As described herein, nowhere in either reference is there any teaching or suggestion of such embodiments. Accordingly, Applicants respectfully request that the §103(a) rejections of the pending claims be withdrawn.

Also as described in the Applicants' previous responses, Applicants respectfully suggest that the Examiner has not met the *prima facie* burden of obviousness for the pending claims

because the Examiner has not pointed to a specific teaching or suggestion in the prior art but has merely provided an unsupported conclusory statement (see, MPEP §§706.02(j), 2142-2143). The Examiner's statement that it would have been obvious to modify the prior art to "modify Yamamoto's inventive concept to include Kunigami's inventive concept" because "this would have ensure [sic] that user/customer [sic] receive quality of information for the fee paid" is not sufficient to meet the Examiner's burden of providing a *prima facie* case of obviousness. The Examiner's conclusory statement does not address a single limitation of any presently claimed embodiment, and offers no viable motivation or suggestion to combine. Applicants have reviewed both the references and have been unable to locate any motivation or suggestion in either reference that would have led one skilled in the art, at the time of invention, to combine the Yamamoto and the Kunigami references. The Examiner's proposed combination of Yamamoto and Kunigami, having been compiled "without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight" (*In Re Dembicza*k, 175 F.3d 994, Fed. Cir., 1999).

#### A. Claims 4-10 and 15-18

Applicants respectfully disagree with the Examiner's assertion that the Yamamoto reference teaches determining fees by escalating them based on usage or making them conditional. Applicants have reviewed the sections of the Yamamoto patent cited by the Examiner in support of this argument (abstract, figs 4 and 7, column 11 lines 45-64, column 12 lines 35-59) and respectfully disagree that this, or any other portion of the Yamamoto patent teaches the embodiment of determining fees by escalating them based on usage or making them conditional. Nowhere in the Yamamoto patent is such an embodiment taught or suggested. Nor does the Kunigami patent teach or suggest determining fees by escalating them based on usage or making them conditional. Further, the Examiner has not pointed to a specific teaching or suggestion in the prior art that would have motivated one of ordinary skill in the art to modify the Yamamoto patent in view of the Kunigami patent to perform the step of determining fees by escalating them based on usage or making them conditional. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 4-10 and 15-18.

B. Claims 19, 22, 31, 49, and 50

Applicants respectfully assert that the Yamamoto and Kunigami patents fail to teach, suggest, or render obvious, either alone or in combination, embodiments of the present invention as claimed in independent claims 19, 22, 31, 49, and 50. Claims 19, 22, 31, 49, and 50 are patentable for reasons similar to those given for independent claim 1 above.

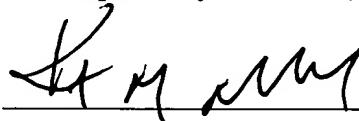
C. Claims 2-3, 11-14, 20-21, 23-30, 32-48, and 51-67

Claims 2-3, 11-14, 20-21, 23-30, 32-48, and 51-67 are believed patentable at least as depending from patentable base claims.

**C O N C L U S I O N**

Accordingly, Applicants respectfully assert that each of the claims are patentable over the cited references, alone or in combination. Applicants therefore respectfully request that the Examiner's rejection of the pending claims be withdrawn. In view of the above, all pending claims are believed patentable over the cited references. Applicants respectfully request allowance of all pending claims. Applicants' silence with respect to other comments made in the Office Action does not imply agreement with those comments. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at 203-972-0081.

Respectfully submitted,



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